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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,472	03/11/2004	Charles Herbert Morris	4616-68081	8371

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EXAMINER

MILLS, DANIEL J

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 09/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/799,472

Applicant(s)

MORRIS, CHARLES HERBERT

Examiner

Daniel J. Mills

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 1-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 18-27 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-27 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-7, drawn to a gate, classified in class 49, subclass 49.
- II. Claims 8-17, drawn to a two component lock, classified in class 403, subclass 322.2.
- III. Claims 18-27, drawn to a hinge, classified in class 16, subclass 366.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable.

Invention III has separate utility such as to hinge a movable countertop section. Invention II has separate utility such as to lock into place a removable section of a roll bar used in an automobile. See MPEP § 806.05(d).

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the gate does not require the use of a lock component with a stub to secure it to a tube, the lock component could instead

be butt welded to a tube. The subcombination has separate utility such as to lock into place a removable section of a roll bar used in an automobile.

Inventions I and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the gate does not require the use of a hinge component with a stub, the lock component could instead be butt welded. The subcombination has separate utility such as to hinge a movable countertop section.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Lisa M. Caldwell on 8/9/2005, a provisional election was made without traverse to prosecute the invention of a hinge, claims 18-27. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-17 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Specification

The abstract of the disclosure is objected to because the language "is disclosed should be deleted from line 1. Correction is required. See MPEP § 608.01(b).

Claim Objections

Claims 21-22 objected to because of the following informalities:

Claims 21-22 recite the limitation "a gate as defined in claim 18" in line 1, this should be changed to "a hinge as defined in claim 18", Examiner is treating these claims with this understood. Correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 18-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Morris (US 2002/0017062).

Regarding claim 18, Morris discloses a hinge for connecting one terminating end of a handrail to a pivoting gate arm made of tubing, the hinge comprising in combination, two connectors (4, 6), each connector comprising, a clevis (41, 61) having two opposed clevis fingers, and a clevis web (48, 68) spanning the base of the clevis fingers, the clevis fingers defining a clevis gap, and a stub (42, 62) for insertion into tubing so as to attach the relevant connector to the tubing, a generally-rectangular parallelepiped link (5 is clearly a generally rectangular parallelepiped), interposed between the clevis fingers of each clevis and pivotally attached to each clevis by a pin (18, 18') through aligned holes (51, 52) in the clevis and the link, wherein the combined

pivoting of each of the connectors relative to the link is such that, when the hinge is installed, a gate arm may pivot relative to a handrail through 180°

Regarding claim 19, Morris discloses a hinge wherein, when the hinge is installed and the gate arm to which it is installed is in a closed position, a portion of the clevis web of each connector abuts the adjoining end of the link (shown in figure 2) so as to impede pivotal movement of the gate arm in the direction opposite an opening direction.

Regarding claim 20, Morris discloses a hinge wherein, when the hinge is installed and the gate arm to which it is installed is in a closed position, the clevis fingers of one connector abut the clevis fingers of the other connector (shown in figure 1) so as to impede pivotal movement of the gate arm in the direction opposite an opening direction.

Regarding claim 21, Morris discloses a hinge wherein each connector abuts the link when each connector has pivoted roughly 90° from a closed position relative to the link (shown in figure 4).

Regarding claim 22, Morris discloses a hinge wherein, when the hinge is installed, a portion of each connector abuts the link when the gate arm to which the hinge is attached is pivoted to a fully open position roughly 180° from a closed position, such that the gate arm is substantially parallel to the adjoining handrail (shown in figure 3A), so as to impede pivotal movement of the gate arm beyond roughly 180° between the closed position and the fully open position.

Regarding claim 23, Morris discloses a hinge wherein, the clevis gaps are of substantially identical widths and the width of the link is slightly less than the width of the clevis gaps and the length of the link is selected to provide substantial peripheral

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continuity of the hinge between the clevis webs, so that the exposed peripheral surfaces of the clevises and exposed surfaces of the link provide substantially-uninterrupted surface continuity between the gate arm and the handrail when the hinge is installed (shown in figure 2).

Regarding claim 24, Morris discloses a hinge wherein the connectors are substantially identical one to the other (as shown in figures 1-4, the connectors are nearly identical).

Regarding claim 25, Morris discloses a hinge wherein the handrail and gate arm are round tubing and each stub is substantially cylindrical and has an external diameter the same as, or slightly smaller than, the internal diameter of the tubing.

Regarding claim 26, Morris discloses a hinge wherein each stub is hollow and is provided with circumferentially-spaced longitudinally-extending slits (11) to permit the stub to be slightly compressed to facilitate insertion into the tubing.

Regarding claim 27, Morris discloses a hinge wherein each stub has one or more retainer wedges (the action of 20 on 10 creates a slightly inclined surface on the outer surface of each of the quadrants of the stub), each retainer wedge having a relatively-long gently-inclined top surface (outer circumference of the stub) that facilitates insertion of the stub into a tubing and a short end surface (the end of the stub) that forms a sharp corner with the gently-inclined top surface, which sharp corner engages the inner wall of the tubing so as to resist removal of the stub.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 18 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 29 of U.S. Patent No. 6,565,069 in view of Daws (US 4,131,378). Claim 29 in US 6,565,069 is largely identical to claim 18 in the current application with the exception of further limiting the "link" (US 6,565,069 column 24 line 4) to be a "generally-rectangular parallelepiped link" which is taught by Daws. It therefore would have been obvious to one of ordinary skill in the art to have

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provided the link of claim 29 of US 6,565,069 to be a generally-rectangular parallelepiped link as taught by Daws, because it has been consistently held that mere change in shape is not inventive absent a showing of criticality.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lin (US 6,413,004), Goodwin (US 5,584,469), Kronenberg (US 5,209,599) are cited for pertaining to applicant's invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel J. Mills whose telephone number is 571-272-8115. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 571-272-7087. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DJM

DJM

8/29/2005

A handwritten signature in black ink that reads "Daniel P. Stodola". The signature is fluid and cursive, with a large initial 'D'.

DANIEL P. STODOLA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600